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In re Application of
HEATHER *et al*
U.S. Application No.: 10/575,925
PCT No.: PCT/GB2004/004400
Int. Filing Date: 15 October 2004
Priority Date: 17 October 2003
Attorney Docket No.: 930058-2006
For: BUILDING MODULES

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 01 May 2007.

BACKGROUND

On 01 March 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 01 May 2007, applicants filed a response which was accompanied by, *inter alia*, the subject petition; a \$130.00 petition fee; a declaration signed by four of the five named inventors; and a copy of a letter and an email sent to the nonsigning inventor.

DISCUSSION

Applicants claim that one of the five named inventors, Richard Clive Ogden, refuses to cooperate¹ in the above-identified application and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 01 March 2007.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor.

¹ Applicants did not suggest that Mr. Ogden could not be located in the subject petition. As such, this claim will not be considered here.

Concerning item (1), the petition fee changed to \$200.00. The \$70.00 difference has been charged to Counsel's Deposit Account No. 50-0320 as authorized.

With regards to item (3), the last known address of the missing inventor has been provided.

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by four of the five co-inventors on behalf of themselves and the nonsigning joint inventor. The residence, address and citizenship of all three inventors are recorded on the declaration. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Regarding item (2), applicants' claim that Mr. Ogden refuses to cooperate. In support of this claim, applicants submitted a copy of a letter dated 31 July 2006 mailed to the last known address of the nonsigning inventor and a copy of an email sent to Mr. Ogden. Applicants state that no response from Mr. Ogden has been received.

This is insufficient to show a refusal to cooperate. Section 409.03(d) of the MPEP discusses a refusal to cooperate and states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted . . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

Here, petitioners have not shown that a complete copy of the application papers

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was forwarded to Mr. Ogden. Both the letter and email did not contain a copy of the application papers. Moreover, there is no evidence presented that Mr. Ogden received any of these documents. Applicants must provide a complete copy of the application papers including a request to sign a declaration to Mr. Ogden and verify that Mr. Ogden (or his representative) received the papers. A signed postal receipt would be sufficient. The failure to respond to a request in a timely manner may constitute a refusal to cooperate. If applicants determine that Mr. Ogden cannot be located, the procedures outlined in section 409.03(d) of the MPEP must be followed and documentary evidence of any search provided.

For these reasons, item (2) of 37 CFR 1.47(a) is not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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